

## **REMARKS**

### **INTRODUCTION**

In accordance with the foregoing, claims 9 and 20 have been amended.

Reconsideration of the allowability of all claims is respectfully requested. No new matter is being presented, and approval and entry are respectfully requested.

Claims 3-7 and 9-34 have been allowed, and claims 1, 2 and 8 stand rejected.

Claims 1-34 are pending and under consideration.

### **ENTRY OF AFTER FINAL AMENDMENT**

In accordance with the Examiner's helpful comments, claims 9 and 20 have been amended to correct antecedent informalities. Withdrawal of this objection is respectfully requested.

### **REQUEST FOR NEW OFFICE ACTION**

Applicants previous response particularly pointed out the lack of **evidenced motivation** in the previous rejections, as required for a prima facie obviousness case, which was not addressed or corrected in the outstanding Office Action. Therefore, it is respectfully submitted that the outstanding Office Action is improper, requiring issuance of a new Office Action addressing applicants previous remarks, as well as proper obviousness rejections based on motivation supported by the record.

In particular, the outstanding rejections do not cite **any** source for the relied upon motivation in rejecting the claims. The motivational rationale is based solely on features found by the Examiner and the Examiner's conclusion that if combined the modified references would disclose the claimed invention. Regardless of whether claimed features are disclosed in the prior art there must still be evidenced motivation for either their combination or modification.

The proffered motivation for each outstanding rejection is not evidenced in the record. For example, the motivational rationale for rejecting claim 1 is that "[i]t would have been obvious.... to incorporate the recording/writing functionality into the smart card/reader system to provide up-to-data to the trading/payment card." This motivation is a conclusory statement not evidenced in the record.

Similarly, the rejection of claim 8 is based solely on the conclusion of the Examiner that it would have been obvious to combine two references, "in order to keep track of the

pictures/images by their serial number to further provide a capability to display a desired picture/image by its serial number or to sequentially display the pictures/images on the display unit.”

Accordingly, as noted in the previous response, the outstanding rejections do not rely upon any motivation supported by the record, but rather are based on the Examiner’s opinion, derived solely from the attempt to force the relied upon references to read on the claimed invention. Thus, the previous and current rejections are improper.

The outstanding Office Action has also failed to address the previous remarks pointing out the lack of evidenced motivation. The Office Action does recite portions of the remarks, but does not address the same.

As noted in at least MPEP 707.07(f), the Examiner is required to answer and address all traversals. This requirement is in addition to any repetition of a previously held position and is required to allow the applicant a chance to review the Examiner’s position as to these arguments and to clarify the record for appeal.

Additionally and as further noted in MPEP 707.07(f), a failure of the Examiner to address the applicant’s traversals can be deemed a failure to rebut these arguments so as to admit that the arguments have overcome the rejection. **At the very least, the failure to address the applicant’s traversals would render the Examiner’s decision to again reject the claims arbitrary and capricious and invalid under the Administrative Procedures Act, 5 U.S.C. § 706, the standard under which such rejections are reviewed in view of Dickinson v. Zurko, 527 U.S. 150, 50 USPQ2d 1930 (1999).**

As such, since the Examiner has not addressed the applicant’s traversals, presented in the previous response, addressing the lack of evidenced motivation, it is respectfully requested that the Examiner withdraw the Final Office Action and issue a new Office Action addressing the same.

Applicant further respectfully requests that any new Office Action particularly meet the required prima facie obviousness standard, e.g., motivation must evidenced in the record.

#### **STANDARDS FOR PRIMA FACIE OBVIOUSNESS CASE**

To set forth a prima facie §103 rejection, there must be some evidenced reason for modifying a reference. Specifically, there must be evidence, outside of the present application, which motivates, leads, or suggests to one of ordinary skill to modify a reference. In addition, an "obvious to try" rationale for combining two references is not valid motivation under 35 USC §103. In re Goodwin, 576 F.2d 375, 377, 198 USPQ 1, 3 (CCPA 1978); In re Antonie, 559 F.2d

618, 195 USPQ 6 (CCPA 1977); In re Tomlinson, 363 F.2d 928, 150 USPQ 623 (CCPA 1966).

As the outstanding rejections would appear to be based on a similar argument, i.e., one skilled in the art would have tried to combine the references as the Examiner suggests, the same rationale is improper.

Similarly, the mere fact, however, that the prior art may be modified in the manner suggested in the Office Action does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

Further, it is well settled that "the Board [and Examiner] cannot simply reach conclusions based on [their] own understanding or experience - or on [their] assessment of what would be basic knowledge or common sense. Rather the Board [and Examiner] must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F. 3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also In re Lee, 277 F. 3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), in which the court required evidence for the determination of unpatentability by clarifying that the principles of "common knowledge" and "common sense" may only be applied to the analysis of evidence, rather than be a substitute for evidence.

Thus, accordingly, a prima facie obviousness rejection requires evidenced motivation from something in the record that would suggest or lead one skilled in the art to combine the relevant teachings.

Regarding the outstanding rejections, the outstanding rejections merely recite what features can be found in differing references and thereafter concludes that it would have been obvious to combine the same. There is no support in the Office Action for any need or desire for the proffered combinations/modifications; the only need or desire for the same comes from the Examiner and the underlying desire to build the claimed invention.

Accordingly, it is respectfully submitted that the outstanding rejections fail to meet the above noted prima facie obviousness requirements.

**REJECTION UNDER 35 U.S.C. § 103:**

Claims 1 and 2 stand rejected under 35 USC § 103(a) as being obvious over Yamashina, JP10-138667, in view of Moreno, U.S. Patent No. 4,007,355. This rejection is respectfully traversed. A majority of the following is restated from the previous response, as a convenience to the Examiner.

By way of review and as an example, independent claim 1 sets forth:

"[a] trading card communicating with recording and/or reproducing units to receive messages from a subject printed on the trading card, the trading card comprising:

a data storage unit storing subject-related data of the subject printed on the trading card, wherein the data storage unit reproduces and transmits the subject-related data to the recording and/or reproducing units in the form of an optical or radio signal to simultaneously reproduce the subject-related data of the subject printed on the trading card in the recording and/or reproducing units, wherein the data storage unit receives a recording command from the recording and/or reproducing units to record the subject-related data stored in the recording and/or reproducing units from the subject."

The Office Action has indicated both that it would have been obvious to combine Yamashina and Moreno and that the combination of the same would disclose the presently claimed invention. Applicant respectfully disagrees.

Yamashina would appear to merely be a trading card matched with a **CD-ROM, or related disc type recording device**. In FIGS. 1, 7, 9, 10 and 11, for example, Yamashina illustrates this matching back-to-back of the trading card and the CD. FIGS. 1 and 9 illustrate the trading card having a similar width as the diameter of the CD (encapsulating the CD), while FIGS. 5, 7 and 10 illustrate the trading card having a width smaller than the diameter of the CD (encapsulated by the CD). Regardless, in both examples the system of Yamashina is merely the matching, back-to-back, of the CD to a trading card.

FIG. 8, of Yamashina, further illustrates that to read information from the CD of the trading card/CD combination **must** be placed in a reader 7, with that read information being played on the monitor 8.

The Office Action would appear to also mistakenly have referred to this FIG. 8, when the Office Action indicates that Yamashina, in paragraph [0056], "teaches the data storage unit receives a command from the recording and/or reproducing apparatus to reproduce/display image information (see paragraph 56)." However, Paragraph [0056] of Yamashina refers to FIG. 8, and the communication between read-out equipment 7, monitor 8, and mouse 9, and the

controlling of read-out equipment 7 to start reading information from the CD of Yamashina and forward image information to monitor 8.

Thus, in Yamashina, as relied upon by the Examiner, the interpreted corresponding "data storage unit" does not receive any commands from a recording and/or reproducing apparatus. There is no disclosed or suggested device in the trading card/CD combination of Yamashina that would enable the same to perform such reception of commands or reproduction of information stored on the CD. Therefore, the proffered combination of references at least fails to disclose this claimed feature.

Thus, Yamashina would appear to merely illustrate a trading card matched with a CD, with the reproduction of information from the CD being implemented according to conventional methods.

As noted above, the Office Action has indicated that it would have been obvious to modify Yamashina to include recording and/or reproducing units recording subject-related data stored in the recording and/or reproducing units onto the trading card/CD of Yamashina.

To disclose this feature, the Office Action relies on Moreno, which would appear to only disclose a smart card with a memory for cash transactions.

The Office Action sets forth that "[i]t would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the recording/writing functionality into the smart card/reader system in order to provide up-to-data to the trading/payment card."

Thus, the Office Action is setting forth the rationale that it would have been obvious to incorporate the claimed data storage unit command receipt to "record the subject related data stored in the recording and/or reproducing units from the subject," "in order to provide up-to-data to the trading/payment card."

However, this rationale would appear to be improper, i.e., the recited motivation to add the claimed element is for Yamashina to include the claimed element. The Office Action sets forth features disclosed by Moreno and then concludes the same would be modifiable into Yamashina since Yamashina would then have those features. It is respectfully submitted that this is not proper motivation.

**There must be something in the record, outside of the present application, that indicates that it would have been beneficial, needed, or desired to incorporate this feature into Yamashina. The record is silent as to why Yamashina would need or desire such a claimed feature of recording to the data storage unit. Rather, it is respectfully submitted that recited motivation is only based on the Examiner's opinion and/or conclusions, and**

**not evidence in the record.**

Further, the Office Action relies on Yamashina to disclose the claimed data storage unit receiving a recording command to incorporate the recording feature of Moreno. However, as the data storage unit of Yamashina does not include this command receipt feature, then the addition of the corresponding feature from Moreno similarly wouldn't be applicable.

Lastly, it is respectfully submitted that the proffered combination would not have been obvious without the knowledge and disclosure presented in the present application. Yamashina discloses only a CD mated with a trading card. Moreno sets forth a smart card for cash transactions. The implementation of the cash card smart card in the trading card of Yamashina can only be derived from the disclosure of the present invention. Without the combination of such divergent features in the present invention there would not have been any base for the combination of such divergent references.

Accordingly, it is respectfully submitted that it would not have been obvious to modify Yamashina, in view of Moreno, to disclose the presently claimed invention. In addition, as noted above, it is respectfully submitted that, even as combined, the proffered combination fails to disclose the presently claimed invention.

Therefore, for at least the above, reconsideration of the allowability of claims 1 and 2 is respectfully requested.

Claim 8 stands rejected under 35 USC § 103(a) as being obvious over Yamashina, in view of Raasch et al., U.S. Patent No. 5,956,877. This rejection is respectfully traversed.

By way of review and as an example, independent claim 8 sets forth:

"[a] system, comprising:

a magazine loading trading cards, processing subject-related data stored in the trading cards, and transmitting the subject-related data, wherein the subject-related data comprises moving pictures arranged in a sequence using serial numbers; and

a recording and/or reproducing apparatus receiving the subject-related data and processing the serial numbers to sequentially reproduce the moving pictures via a display unit."

Similar to above, the Office Action indicates that Yamashina discloses a majority of the claimed features. The Office Action sets forth that Yamashina discloses, in paragraphs 50-57, a system "transmitting subject related data" stored on a trading card, wherein the subject-related data comprises moving pictures; and a recording and/or reproducing apparatus receiving the subject-related data and processing to produce the moving pictures via a display unit."

As noted above, it is respectfully submitted the paragraphs [0050]-[0056] have been

misunderstood. Yamashina only illustrates a read-out device 7 for reading information from the CD of the trading card/CD, with the read-out device 7 then processing the read information for display on monitor 8.

However, independent claim 8 particularly sets forth: (a) "a magazine loading trading cards, processing subject-related data stored in the trading cards, and transmitting the subject-related data..."; and (b) "a recording and/or reproducing apparatus receiving the subject-related data .. [to] reproduce the moving pictures via a display unit."

The CD of the Yamashina trading card does not process subject-related data stored on the trading card or transmit the subject-related data, as claimed. Yamashina only discloses a CD of the trading card (a) being readable by a read-out device 7 (b).

In addition, similar to above, the Office Action has concluded that the sequential arrangement of moving pictures in the trading cards and the sequential reproduction of the same would have been obvious merely based on the disclosure of Raasch et al. implementing a sequential feature. **The motivational rationale for the combination of Raasch et al. and Yamashina is based solely on Raash et al. disclosing a feature and the Examiner's opinion that such an addition to Yamashina would have been obvious because the combination would then have that feature. There must be something in the record providing a need or desire in Yamashina for such a modification. The fact that Raasch et al. derives benefits from the same does not make the addition of that feature obvious in Yamashina.**

Accordingly, it is respectfully submitted that it would not have been obvious to combine Yamashina with Raasch et al. to disclose the presently claimed invention. In addition, as noted above, it is respectfully submitted that the proffered combination also fails to disclose the presently claimed invention.

Therefore, reconsideration of the allowability of claim 8 is respectfully requested.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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